



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,131	12/06/1999	DILLIS V. ALLEN	G-31	8757

7590 12/23/2005

DILLIS V. ALLEN, ESQ.
105 S. ROSELLE ROAD
SUITE 101
SCHAUMBURG, IL 60193

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/378,131	ALLEN, DILLIS V.	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 11/15/2004 – letter styled, “SECOND REQUEST TO HAVE THE FINAL ACTION OF MAY 4, 2004 VACATED”.

Response to Amendment

Upon further review, it has been determined that the maintenance fee for U. S. patent RE 36,950 was timely paid. It is again noted that RE 36,950 is a reissue of U.S. Patent 5,301,941. Any inconvenience and delay to the applicant regarding this matter is sincerely regretted.

The finality of the rejection of the Office action, mailed 05/04/2004, has been revisited. In view of the confusion over the maintenance fees presented in this application and in further view of the withdrawal of indicated allowable subject matter, as set forth herein below, the finality of the 05/04/2004 action is withdrawn.

Claims 19-28 remain pending.

Following is an action on the MERITS:

In consideration of the merits of claims 19-28, reference is made to the last amendment presenting changes to the claims, namely the amendment received 02/02/2004. This particular amendment proposes changes for claims 19-26. The text of claims 27 and 28 used for an examination on the merits is as outlined in the amendment of 09/12/2003.

The indicated allowability of claim 28 is withdrawn. A new rejection follows:

Art Unit: 3711

Claims 19-28 STAND rejected as being based upon a defective oath under 35 U.S.C. 251. See 37 CFR 1.175. See the further comments noted herein below under the section styled, "Response to Arguments".

Applicant is again advised of the practice set forth in MPEP §1451, page 1400-54, and titled, "CONTINUATION REISSUE APPLICATION". Applicant is advised to maintain a clear line of demarcation between the instant claims and the claims of the parent file in order to avoid the need to address the possible existence of double-patenting. Applicant is again directed to MPEP §1451. See the further comments noted herein below under the section styled, "Response to Arguments".

Rejections based upon recapture

Claims 19-26 and 28 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

Applicant's attention is drawn to MPEP §1412.02, which states that:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. §251.

Applicant's attention is also drawn to the decisions *In re Clement*, 131 F.3d 1464, 45USPQ2d 1161 (Fed.Cir. 1997), as well as *Hester Industries, Inc., v. Stein, Inc.*, before the United States Court of appeals for the Federal Circuit, decided May 07, 1998.

In this case, and as to claims 19-26, these claims raise the question of recapture of claimed subject matter, since these claims are both broader and narrower in scope than claims amended to secure an allowance in the application for the patent upon which the present reissue is based. While these claims present some narrowing limitations, it has been determined that the narrowing limitations do not have a material aspect to them. More specifically, claims 19-26 and 28 are fashioned similar to claim 15 of the original patent (U.S. Pat. No. 5,301,941) to which this reissue pertains. Claims 19-26 and 28 however, lack the recitation of "substantially uniform thickness" in describing the body wall, said limitation being included within patented claim 15 to distinguish over the art of record during the prosecution history of the application of the patent. With the 02/02/2004 amendment, applicant has instead chosen to use the language "being substantially planar and relatively thin" to describe the characteristics of the ball striking wall, in at least claims 19-26. It is noted that the newly proposed language "substantially planar and relatively thin" contains no vestige of the original limitation "substantially uniform thickness" used in the original patented claims. In other words, claims 19-26 are broader in that claims 19-26 eliminate the requirement for a uniformly thickened ball striking wall. If the newly proposed language could possibly be construed as narrowing to any degree, it would further be noted that the narrowing limitation of "planar and relatively thin" does not save claims 19-26 from the recapture

Art Unit: 3711

doctrine, since during the prosecution of the original patent, the applicant added language relating to the shape and size of the body wall (i.e., a body wall of uniform thickness) in order to overcome the prior art of record.

With the 09/12/2003 amendment, Claim 28 is drafted absent any recitation regarding a "substantially uniform thickness" criteria. Thus, claim 28 is broader in scope than claims amended to secure an allowance in the application for the patent upon which the present reissue is based. In addition, at least claim 19 of the 02/02/2004 amendment calls for a face height of "about 1.4 inches", where in fact the original patent claims (i.e., claim 15 of U.S. Patent 5,301,941) call for a face height of "at least 1.40 inches".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the language "substantially planar and relatively thin" is deemed to be new matter. Nowhere within the confines of the original specification is there any mention whatsoever of a planar ball striking wall or

face, much less any mention of what is considered to be relatively thin when discussing the front face or forward wall.

Allowable Subject Matter

New claim 27 appears to be allowable over the prior art of record.

Response to Arguments

In further response to the arguments set forth in the 02/02/2004 amendment, note the following comments:

Applicant's remarks in the 02/02/2004 Amendment indicating that the requirement for a supplemental oath will be complied with at such time as this application is in condition for allowance is acknowledged.

Applicant's remarks in the 02/02/2004 Amendment requesting that the requirement for filing a "Certificate of Correction" to provide the proper continuing data entry in the parent application be deferred until this application is in condition for allowance is acknowledged.

Applicant's request in the 02/02/2004 Amendment for a clarification with respect to the earlier indicted allowability of claim 28 despite the lack of claim 28 to highlight a "substantially uniform face thickness" is acknowledged. The indicated allowability of claim 28 has been withdrawn, with an explanation having been provided, supra, under the section styled, "Rejections based upon recapture".

With respect to applicant's amendment to all of claims 19-26 to now include the language "substantially planar and relatively thin", the applicant notes that this language more appropriately defines the distinction between the face wall of the present

Art Unit: 3711

application and the non-planar very thick face wall of the prior art and that this language can possibly be argued to be broader in some respects and narrower in other respects than the language "substantially uniform thickness" used in the claims of the original patent. In response, a complete explanation of why the newly proposed claimed subject matter presents an instance of impermissible recapture in this application is outlined above under "Rejections based upon recapture". No further explanation is deemed necessary, here.

Observations regarding concurrent litigation

The patent sought to be reissued by this application is involved in litigation. Any further documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action. While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

A ONE-MONTH SHORTENED STATUTORY PERIOD FOR RESPONSE HAS BEEN SET IN WHICH TO RESPOND TO THE ABOVE-MENTIONED REMARKS AND REJECTIONS. This one-month period may be extended only upon a showing of *clear justification* pursuant to 37 CFR 1.136(b).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
December 14, 2005


Sebastiano Passaniti
Primary Examiner